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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/876,690

06/07/2001

Brian Collamore

US010390

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08/26/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

08/26/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN COLLAMORE, UAN S. KANG,
and JOSEPH M. LUSZCZ

Appeal 2009-003951
Application 09/876,690
Technology Center 3600

Decided: August 26, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Brian Collamore, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 6-10, 12-16, and 18-21. Claims 5, 11, 17, 22, and 23 have been cancelled. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention “relates ... to a system for enabling the reconsideration of a medical study in a medical information management system based on the arrival of new information.” Specification 1:7-8.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A medical information management system, comprising:
 - an information acquisition device;
 - a computer coupled to the information acquisition device, the computer including logic for receiving information from the information acquisition device, for setting a reconsider flag to indicate that new information is available for informing a user of arrival of the new information associated to a study to which the new information corresponds if the study has been reviewed, for not setting the reconsider flag if the study has not been reviewed even when the new information is available, for notifying the user if the user is currently reviewing the study, and for not notifying

¹ Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Apr. 14, 2008) and the Examiner’s Answer (“Answer,” mailed Jun. 25, 2008).

the user if the user is not currently reviewing the study; and
a memory element associated with the computer, where the
memory element stores the information and associates the
information with the study.

THE REJECTION

The Examiner relies upon the following as evidence of
unpatentability:

Myers	US 5,832,450	Nov. 3, 1998
Rapaport	US 6,192,112 B1	Feb. 20, 2001
Judd	US2002/0087503 A1	Jul. 4, 2002

The Examiner took Official Notice that the technique by which,

a computer coupled to the information acquisition device,
for setting a flag if the study has been reviewed and for
not setting [] the reconsider flag if the study has not been
reviewed even when the new information is available, for
notifying the user if the user is currently reviewing the
study, and for not notifying the user is the user is not
currently reviewing the study ... is notoriously well
known.

Answer 4.

The following rejection is before us for review:

1. Claims 1-4, 6-10, 12-16, and 18-21 are rejected under 35 U.S.C.
§103(a) as being unpatentable over Judd, Myers, Rapaport, and
Official Notice.

ARGUMENTS

The Examiner combined Judd, Myers, Rapaport, and Official Notice to reach the determination of obviousness for the claimed subject matter. The Examiner relied on Judd for its disclosure of a system comprising an information acquisition device, a memory element as claimed, and a computer coupled to the information acquisition device that includes logic for receiving information from the information acquisition device.

Judd was also relied upon for disclosing the setting of a reconsider flag to indicate that new information is available. Answer 3. (citing [0067], and Fig. 2 of Judd). However, the Examiner stated that Judd fails to show setting a flag if the study has been reviewed and not setting a flag if the study has not been reviewed, even when the new information is available, as claimed. Answer 4. According to the Examiner, the technique as claimed is notoriously well known and the Examiner cited Microsoft Outlook®, Rapaport (col. 28, l. 55 - col. 29, l. 3), and Myers (col. 9, ll. 63-67) in support thereof. Answer 4.

The Examiner found that,
[o]ne of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Rapaport, Myers and Official Notice with the teachings of Judd with the motivation of providing an effective means of notifying pertinent parties on the status of information.
Answer 4.

The Appellants conceded that “flags and conditional flags are well known” (App. Br. 12) but argue that the cited references do not disclose using flags in the manner set forth in the claims.

According to the Appellants, “Judd is completely silent about using any flags, let alone setting or not setting a flag under the under the specific conditions recited in [the claims].” App. Br. 12.

According to the Appellants, “[t]he particular conditions for flag setting and notification recited in [the claims] are ... [not] considered common knowledge.” App. Br. 13. “If it is common knowledge, then the Examiner should have no trouble finding a prior art reference showing the same; yet no such prior art reference is provided.” App. Br. 13.

According to the Appellants, [t]he alerts disclosed in Rapaport and the use of notifications disclosed in Myers do not remedy the deficiencies in Judd and Official Notice.” App. Br. 14.

ISSUE

Do the prior art references disclose or render obvious, to one of ordinary skill in the art, the claimed invention where the “computer include[es] logic for ... setting a reconsider flag to indicate that new information is available for informing a user of arrival of the new information associated to a study to which the new information corresponds if the study has been reviewed, for not setting the reconsider flag if the study has not been reviewed even when the new information is available, for notifying the user if the user is currently reviewing the-study, and for not notifying the user if the user is not currently reviewing the study”? (claim 1).

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer 3-4 and Final Rejection 2-4.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham*, 383 U.S. at 17-18.

ANALYSIS

Claim 1 is directed to a medical information management system. Were the claimed system simply a medical information management system, it would be no different than the systems described in Judd, Rapaport, and Myers, all of which disclose medical information management systems.

However, the system of claim 1 comprises an information acquisition device, a computer coupled to the information acquisition device, and a memory element associated with the computer, where the memory element stores the information and associates it with a study. But that particular combination of elements appears to be disclosed in the cited prior art, namely Judd (*e.g.*, Fig. 2, and [0084]), as the Examiner has explained (Answer 3). This is not in dispute.

We now come to the remaining claim limitation - the one at issue - the particular logic included in the computer of the claimed system. That the computers disclosed in the cited references include a logic per se is not in dispute. The only question is whether one of ordinary skill in the art would have been led to the claimed system comprising a computer that includes the particular logic as set forth in the claim.

It is notable that the particular logic set forth in the claim is recited solely in functional language. That is, the logic is described in terms of being capable of performing

- receiving information from the information acquisition device;
- setting a reconsider flag to indicate that new information is available for informing a user of arrival of the new information associated to a study to which the new information corresponds if the study has been reviewed,

- not setting the reconsider flag if the study has not been reviewed even when the new information is available,
- notifying the user if the user is currently reviewing the study, and
- not notifying the user if the user is not currently reviewing the study.

App. Br.6-7 and 13-14.

No structural detail is provided. “[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.” *In re Swinehart*, 439 F.2d 210, 212. (CCPA 1971). But there is a danger in doing this. If the Examiner can show that the logic included in the prior art computers are inherently *capable* of performing these functions, the burden shifts to Appellants to prove that the logic shown in the prior art does not possess the characteristic for performing the recited functions. *See In re Schreiber*, 128 F.3d 1473, 1477-78. (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has the capability of functioning in the same manner).

The Examiner properly addressed all the claim limitations. As part of the establishing of a prima facie case of obviousness, the Examiner relied on Judd as showing a “logic for receiving information from the information device, for setting a reconsider flag to indicate that new information is available for informing a user of arrival of the new information a study to which the new information corresponds” (Answer 3) and on Rapaport, Myers, and Official Notice for techniques for performing the other functions recited in the claim not expressly disclosed in Judd. We find that this analysis meets the Examiner’s burden of establishing a prima facie case of

obviousness for the claimed system comprising a computer including a logic capable of performing the recited functions.

Accordingly, the burden shifted to the Appellants to prove that the combined system of the cited prior art would *not* possess the characteristic for performing the functions recited in the claim. We have reviewed the Appellants' Brief. The arguments challenging the rejection do not point to any characteristic missing in the logic included the combined system of the cited prior art necessary for performing the functions recited in the claim. Nor do the Appellants point to any characteristic in the logic included the combined system of the cited prior art that would prevent the combined system of the cited prior art from performing the functions recited in the claim. Rather, the Appellants argue that the cited references do not teach or suggest the *functions* as they are recited in the claim. The Appellants argue that the prior art does not show the particular conditions and flag setting as set forth in the claim. App. Br. 12-14. However, that is an argument distinguishing the claimed system from that of the prior art in terms of the function to be performed, not in terms of the logic used to perform them. The Appellants have not argued that the logic the claimed system uses is structurally different from that which would result from combining the disclosures of the cited prior art. In fact, the "Appellants do not dispute that flags and conditional flags are well known" (App. Br. 12). Accordingly, the Appellants have not proven that the logic shown in the prior art would not possess the characteristic relied upon for performing the recited functions. *See In re Schreiber*, 128 F.3d 1473. (Fed. Cir. 1997).

For the foregoing reasons, we find that the Appellants have not shown error in the rejection.

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-4, 6-10, 12-16, and 18-21 under 35 U.S.C. §103(a) as being unpatentable over Judd, Myers, Rapaport, and Official Notice.

DECISION

The decision of the Examiner to reject claims 1-4, 6-10, 12-16, and 18-21 is affirmed.

AFFIRMED

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